

REMARKS

Claims 1, 7, 11, 18-19, and 23 are currently amended. Claims 4 and 15 were previously withdrawn. Claims 6 and 17 are canceled. Claims 2-3, 5, 9-10, 13-14, 16, 21-22, and 24-27 remain as previously presented. Claims 8, 12, and 20 remain as originally presented.

Rejections under 35 U.S.C. §102(b)

Claims 1-3, 6-7, 9-11, 13-14, 17-18 and 22-27 were rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Aigner. In particular, the Examiner argues that "the flexure would inherently restrict movement in the X and Y planes that are parallel to the plane of the substrate." (emphasis added). Claim 1 has been amended to simply include the limitations of claim 6 as previously considered, and no new claims have been presented.

Anticipation requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631 (Fed. Cir. 1987). In order to establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference . . ." *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (quoting *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268 (Fed. Cir. 1991)). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 745 (quoting *Continental Can Co.* at 1269 (quoting *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981))). The Examiner bears the initial burden to provide a basis in fact and/or technical reasoning to support the allegedly inherent characteristic necessarily flows from prior art. *Ex parte Levy*, 17 U.S.P.Q.2d (BNA) 1461, 1464 (Pat. App. 1990) (Examiner must provide a basis in fact and/or technical reasoning to reasonably support the

BEST AVAILABLE COPY

determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art).

Aigner does not teach or describe "a flexure coupled to one of the retainer bodies, wherein the flexure is configured to resist in-plane lateral movement and allow out-of-plane movement." The Examiner simply states a conclusion that "the flexure [in Aigner] would inherently restrict movement in the X and Y planes that are parallel to the plane of the substrate," without providing a basis in fact or technical reasoning to support such a conclusion. Accordingly, applicants assert that the Examiner has failed to meet the initial burden of proof to support the inherency argument.

In fact, the teachings of Aigner suggest the opposite; that the foil **does not** restrict in plane movement, e.g. in the X and Y planes that are parallel to the plane of the substrate. Aigner states that "the vacuum head . . . can be tilted/inclined," Aigner, claim 20 and paragraph 52, and "is held by a flexible foil." *Id* at claim 22 and paragraphs 53-54. (emphasis added). Euclidean geometry dictates that the "flexible foil" of Aigner does not "restrict movement in the X and Y planes that are parallel to the plane of the substrate" if the vacuum head can be tilted/inclined while attached to the flexible foil.

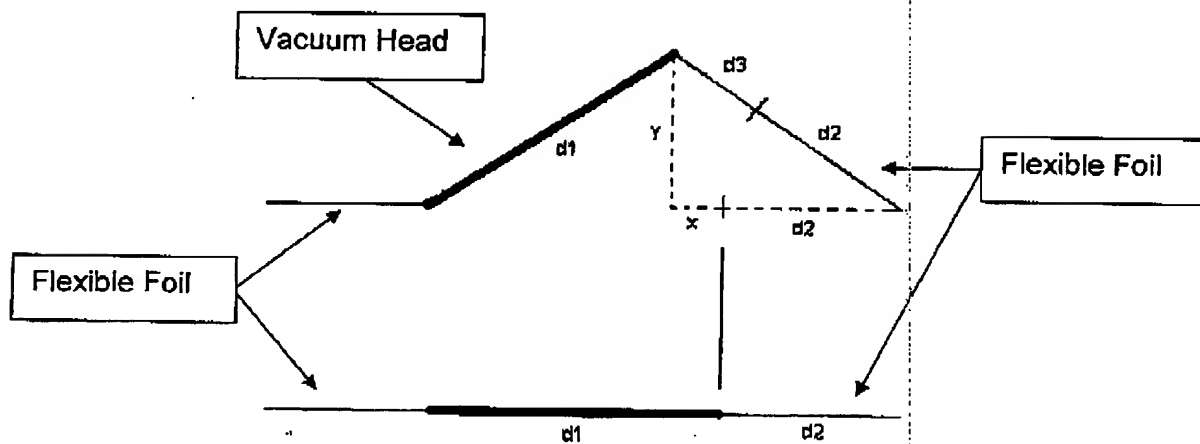


Figure 1 – Aigner's vacuum head inclined

BEST AVAILABLE COPY

Figure 1 shows that the flexible foil must expand when the vacuum head is inclined (assuming distance, d_1 , remains constant). The foil section on the lower right-hand side of Figure 1 has expanded from length, d_2 , to a new length, d_2+d_3 , as illustrated in the upper right-hand side. Therefore, in order to facilitate the vacuum head's inclination, the flexible foil allowed it to move a distance, x , in a plane parallel to the plane of the substrate.

Accordingly, claim 1 is patentable over Aigner under 102(b) because Aigner does not expressly nor inherently describe "a flexure coupled to one of the retainer bodies, wherein the flexure is configured to resist in-plane lateral movement and allow out-of-plane movement." Claims 2-3, 7, and 9-10 depend from independent claim 1 and therefore incorporate each of claim 1's respective limitations. For at least the reasons discussed *supra*, claims 2-3, 7, and 9-10 are patentable over Aigner under 102(b).

In a similar vein, claim 11 is currently amended to require "a flexure coupled to one of the retainer bodies, wherein the flexure is configured to resist in-plane lateral movement and allow out-of-plane movement." Claims 13-14, 18 and 21-22 depend from independent claim 11 and therefore incorporate each of claim 11's respective limitations. For at least the reasons discussed *supra*, claims 11, 13-14, 18 and 21-22 are patentable over Aigner under 102(b).

Furthermore, claim 23 is currently amended to require "a flexure coupled to one of the retainer bodies, wherein the flexure is configured to resist in-plane lateral movement and allow out-of-plane movement." Claims 24-27 depend from independent claim 23 and therefore incorporate each of claim 23's respective limitations. For at least the reasons discussed *supra*, claims 23-27 are patentable over Aigner under 102(b).

Rejections under 35 U.S.C. §103(a)

Claims 5 and 16 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Aigner in view of Gleason. Applicants respectfully traverse these rejections. Gleason does not remedy the deficiency of Aigner discussed *supra*.

- 10 -

IPN P16208 (Intel Corporation)

Attorney Docket No.: 110348-132026
Application No.: 10/779,380

BEST AVAILABLE COPY

Therefore claims 1 and 11 remain patentable over Aigner even when combined with Gleason. Claims 5 and 16 depend from claims 1 and 11 and incorporate their limitations respectively. For at least the reasons discussed *supra*, claims 5 and 16 are patentable over Aigner in view of Gleason under 103(a).

Claims 8 and 20 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Aigner in view of Aigner, and Aigner in view of Sinclair. Applicants respectfully traverse these rejections. Sinclair does not remedy the deficiency of Aigner discussed *supra*. Therefore claims 1 and 11 remain patentable over Aigner even when combined with Sinclair. Claims 8 and 20 depend from claims 1 and 11 and incorporate their limitations respectively. For at least the reasons discussed *supra*, claims 8 and 20 are patentable over Aigner in view of Aigner and Aigner in view of Gleason under 103(a).

Claims 12, 19, 21 and 23-27 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Aigner in view of Zuniga. Applicants respectfully traverse these rejections. Zuniga does not remedy the deficiency of Aigner discussed *supra*. Therefore claim 11 remains patentable over Aigner even when combined with Zuniga. Claims 12, 19 and 21 depend from claim 11 and incorporate its limitations. For at least the reasons discussed *supra*, claims 12, 19 and 21 are patentable over Aigner in view of Zuniga under 103(a).

The Examiner rejected claims 23-27 based on Aigner in view of Zuniga, but failed to present any arguments. Because the examiner has failed to meet the initial burden of establishing a *prima facie* case of obviousness, applicants request the Examiner to withdraw the rejection of claims 23-27 under 35 U.S.C. §103(a) based on Aigner in view of Zuniga. MPEP §706.02(j) (Rev. 2, May 2004).

BEST AVAILABLE COPY

CONCLUSION

In view of the foregoing, Applicants submit that all claims are in condition of allowance. Thus, entry of the offered amendments and early issuance of Notice of Allowance is respectfully requested.

The Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

Dated: 8/5/05

Pacwest Center, Suite 1900
1211 SW Fifth Avenue
Portland, Oregon 97204
Telephone: 503-222-9981


Christopher J. Lewis, Reg. No. 51246

- 12 -

IPN P16208 (Intel Corporation)

Attorney Docket No.: 110348-132026
Application No.: 10/779,380